

Notice of Allowability

Application No.

10/074,020

Examiner

Janet L. Coppins

Applicant(s)

TANIGUCHI ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicants' amendment of July 7, 2006.
2. ☒ The allowed claim(s) is/are 10-18, 22-43 and 46-48.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/646,878.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

Claims 10-18, 22-43, and 46-48 are pending in the instant application.

Information Disclosure Statement

1. Applicants' Information Disclosure Statement (IDS) of July 7, 2006, has been considered by the Examiner. Please refer to the signed copy of Applicants' PTO-1449 form, submitted herewith.

Response to Amendment

2. Receipt is acknowledged of Applicants' Amendment of July 7, 2006. The Examiner notes with appreciation the cancellation of claim 21 and the amendment of claim 48, in order to overcome rejections to the claims. Amendments are also noted to claims 10, 17, 18, and 39 in order to improve clarity.

3. Accordingly, claims 10-18, 22-43, and 46-48 are in condition for allowance.

Reasons for Allowance

In view of Applicants' amendatory changes and cancellations, claims 10-18, 22-43, and 46-48 are allowable, as newly renumbered claims 1-34.

The following is an examiner's statement of reasons for allowance:

The instant application relates to novel propanolamine compounds, their pharmaceutical compositions, processes of preparation, and methods of using them for treating dysuria, pollakiuria, and urinary incontinence, etc. The allowable subject matter in this case is limited to methods of treating various urinary disorders using compounds of formulae (IV)-(VIII) of claim 10, as well as compounds of formula (I) of claims 36, their process of preparation, and their pharmaceutical compositions. The instant application is a CON of 09/646,878, which is now

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U.S. Pat. No. 6,495,546. Certain propanolamine compounds are known in the art as being useful β 3 adrenergic receptor agonists, however the aspect of treating the same conditions as instantly claimed, utilizing compounds of formula (IV)-(VIII), is novel and unobvious. After a thorough search, the closest prior art of record, Fisher et al, U.S. 5,561,142, teaches similar sulfonamide compounds as β 3 adrenergic receptor agonists, yet do not teach the same compounds as instantly claimed, or their uses or preparation. Therefore the prior art fails to anticipate, fairly suggest, or render obvious the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Telephone Inquiry

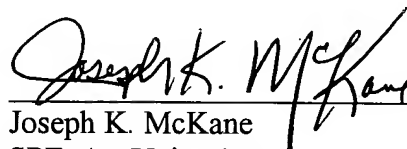
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins
September 26, 2006



Joseph K. McKane
SPE, Art Unit 1626